

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WERNER WALTHER

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Appeal No. 2001-0856  
Application 09/143,947

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ON BRIEF

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Before WARREN, KRATZ and MOORE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*Decision on Appeal*

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1 through 5 and 8 through 15. Claim 1 is illustrative of the claims on appeal:

1. A process for finishing flexible or stretchable substrates comprising the steps of:
  - a) applying to the surface of said substrate an aqueous polymeric composition (C) comprising at least one polymeric binder (A) , optionally at least one foam stabilizer (B) and an amount of solvent blowing agent boiling in the range of from 40 to 60°C, effective to foam said composition; and
  - b) applying heat to the coated substrate to foam and cure said polymeric composition (C) to form a flexible foam coating fixed to the substrate surface.

The appealed claims, as represented by claim 1, are drawn to a process of forming a flexible foam coating fixed to a flexible or stretchable substrates comprising at least the steps of applying an aqueous polymeric composition comprising at least one polymeric binder and an

effective amount of a solvent blowing agent boiling in the range of from 40 to 60°C, and applying heat to form and cure the composition.

The reference relied on by the examiner is:

Spek et al. (Spek) 4,833,173 May 23, 1989

The examiner has rejected appealed claims 1 through 5 and 8 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Spek.<sup>1</sup>

Appellant states in the brief (page 3) that the appealed claims “stand or fall together.” Thus, we decide this appeal based on appealed claim 1. 37 CFR § 1.192(c)(7) (2000).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the examiner’s answer and to appellant’s brief and reply brief for a complete exposition thereof.

### *Opinion*

Our consideration of the examiner’s application of prior art to appealed claim 1 must, of course, begin with interpreting the language of the claims in light of the written description in appellant’s specification as it would be interpreted by one of ordinary skill in this art. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997) (“[T]he PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow. When the applicant states the meaning that the claim terms are intended to have, the claims are examined with that meaning, in order to achieve a complete exploration of the applicant’s invention and its relation to the prior art. *See In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) (before the application is granted, there is no reason to read into the claim the limitations of the

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<sup>1</sup> The examiner has withdrawn the grounds of rejection under 35 U.S.C. § 103(a) over Snider, Liman and Horn (answer, page 2). See the Office action of November 11, 1999 (Paper No. 7).

specification.).” In doing so, we will give the terms used in the claims their ordinary meaning unless another meaning is intended by appellant as established in the written description of the specification, and the limitations of the specification, or any preferred embodiment or example therein, will not be read into the claims. *See generally, Morris, supra; see also Zletz, supra; In re Priest*, 582 F.2d 33, 37, 199 USPQ 11, 15 (CCPA 1978); *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). In this respect, it is appellant’s burden to define the claimed invention encompassed by the appealed claims in the specification. *See Morris*, 127 F.3d at 1055-56, 44 USPQ2d at 1029.

We interpret the terms “flexible or stretchable substrates” and “polymeric binder” to encompass any substrate which is flexible or stretchable and any polymeric binder that will interact with any solvent blowing agent boiling in the range of from 40 to 60°C to form a foam that is fixed to the substrate surface, respectively. The term “solvent blowing agent boiling in the range of from 40 to 60°C,” of course, encompasses any such solvent blowing agent that will interact with a polymeric binder to form the foam. Thus, we do not read into the claim terms the preferred materials that appellant relies on to distinguish the claimed process over the teachings of Spek (brief, e.g., page 8; reply brief, e.g., page 2).

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported position advanced by the examiner (answer, pages 3-4) that, *prima facie*, one of ordinary skill in this art routinely working within the teachings of Spek would have found therein the suggestion that any water insoluble solvent having a boiling point between -40°C and +50°C can be used as a physical foaming agent in an aqueous polymer composition containing a coagulable polymer latex in a process of impregnating a flexible textile cloth with the composition and foaming the composition, with the reasonable expectation of obtaining a product taught in the reference (e.g., col. 3, lines 12-31, and col. 4, lines 33-42). *See generally, Merck & Co., Inc. v. Biocraft Labs., Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1845-46 (Fed. Cir. 1989); *In re Lemin*, 332 F.2d 839, 841, 141 USPQ 814, 815-16 (CCPA 1964).

The examiner finds that the solvent blowing agent boiling point range specified in appealed claim 1 and taught in Spek “read on each other” (answer, page 4), and we agree that the two ranges overlap. It is well settled that where the claimed ranges are encompassed by or

overlap with the ranges for the same parameters disclosed in the applied prior art, the claimed ranges will not patentably distinguish the claimed invention from the prior art unless the claimed ranges are shown to be critical, such as by a showing of a new or unexpected result, thus shifting the burden to appellant to establish the criticality of the claimed ranges. *See generally, In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990) (“The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. [Citations omitted.] These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by showing that the claimed range achieves unexpected results relative to the prior art range. [Citations omitted.]”); *see also In re Geisler*, 116 F.3d 1465, 1470, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997); *In re Boesch*, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980).

Accordingly, based on the evidence in *Spek*, one of ordinary skill in this art routinely working within the teachings of the reference would have arrived at the claimed process.

Accordingly, since a *prima facie* case of obviousness has been established *Spek* by the examiner, we have again evaluated all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant’s arguments. *See generally, In re Johnson*, 747 F.2d 1456, 1460, 223 USPQ 1260, 1263 (Fed. Cir. 1984); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have carefully considered all of appellant’s arguments. We recognize, as pointed out by appellant (brief, page 8; reply brief, page 2), that *Spek* does not teach the exact solvent blowing agent boiling point range specified in appealed claim 1. However, the claimed and reference range clearly overlap from 40 to 50°C, and appellant has not presented objective evidence or affective argument of the criticality of the solvent blowing agents therein. Furthermore, we are not convinced that appealed claim 1 distinguishes over *Spek* because the reference does not disclose the particular type of solvent blowing agent, since appealed claim 1 specifies *any* solvent blowing agent boiling in said range as we interpreted this claim above. We find no basis in the plain language of appealed claim 1 on which to read any preferred embodiment, substrate, polymeric binder or solvent blowing agent into the claim.



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